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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,563	09/28/2001	Masaaki Nishikiori	1086.1139CIP	2578
21171	7590	09/09/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,563

Applicant(s)

NISHIKIORI ET AL. *GT*

Examiner

John M Winter

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-16 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### Status

Claims 1-16 have been examined

### *Claim Rejections - 35 USC §101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1 the applicant claims a mediation negotiating method of mediating a negotiation between a requestor and responders by using a network, the method includes forming a request and receiving a response. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts. (Examiner notes that the term "using a network" does not place the claimed invention within the technological arts, since a network might be construed as an associated group of people)

In claim 14 the applicant claims negotiation responding method, similar in scope to claim 1.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F3d at 1358, 50 USPQ2d at 1452.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1,2, and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo (US Patent 5,895,450) in view of Burchetta et al. (US Patent 6,330,551)

As per claim 1,

Sloo ('450) discloses a mediation negotiating method of mediating a negotiation between a requestor and responders by using a network, comprising:

a negotiation requesting step which forms a negotiation field, inputs said requesting conditions, and notifies the requesting conditions to the responders selected in accordance with said requesting conditions;(Column 7, lines 66-67; column 8 lines 1-4)

a negotiation responding step which receives response information from the responders who participate in said negotiation field and notifies said requestor and the other responders of the received response information.(Column 8, lines 33-58; figure 7)

Sloo ('450) does not explicitly disclose "a request forming step which forms requesting conditions in which priorities have been allocated to request contents in response to a mediating request of said requestor", Burchetta et al. ('551) discloses "a request forming step which forms requesting conditions in which priorities have been allocated to request contents in response to a mediating request of said requestor".(Column 2, lines 3-13; Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

Claims 12 and 13 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,

Sloo ('450) discloses a method according to claim 1

wherein in said request forming step, priorities are allocated to request articles or the request contents such as service, price, term of delivery, and the like, thereby forming the requesting conditions with said priorities as said requesting conditions.(Column 7, lines 66-67; column 8 lines 1-4; figure 3)

As per claim 4

Sloo ('450) discloses a method according to claim 1

Sloo ('450) does not explicitly disclose "an abstract mediating request from the requestor is analyzed and one or a plurality of requesting conditions are formed", Burchetta et al. ('551) discloses "an abstract mediating request from the requestor is analyzed and one or a plurality of requesting conditions are formed".(Column 7, lines 26-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 5,

Sloo ('450) discloses a method according to claim 1

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Sloo ('450) does not explicitly disclose "the request contents including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again", Burchetta et al. ('551) discloses "the request contents including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again".(Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 6,

Sloo ('450) discloses a method according to claim 1

Wherein in said negotiation requesting step, if there are a plurality of requesting conditions, the responder is selected under a condition that he corresponds to at least one of said plurality of requesting conditions, and the negotiation field between said requestor is formed.(Column 8, lines 5-19)

As per claim 7,

Sloo ('450) discloses a method according to claim 1

Wherein In said negotiation requesting step, a negotiation term is set into said negotiation field and the requesting conditions are inputted,(Figure 3) and in said negotiation responding step, the end of the negotiation is discriminated and the negotiation field is closed.(Figure 7)

As per claim 8,

Sloo ('450) discloses a method according to claim 7

wherein in said negotiation responding step, the negotiation field is closed by a negotiation decision instruction of said requestor or an expiration of the negotiation term.(Column 8, lines 44-58)

As per claim 9,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "the negotiation term is extended on the basis of an instruction from the requestor", Burchetta et al. ('551) discloses "the negotiation term is extended on the basis of an instruction from the requestor".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 10,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the

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Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 11,

Sloo ('450) discloses a method according to claim 10

Sloo ('450) does not explicitly disclose "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 14,

Sloo ('450) discloses a negotiation responding method comprising:

a receiving step which receives request information inputted into a negotiation field formed on a network ;(Column 7, lines 66-67; column 8 lines 1-4; figure 3)

Sloo ('450) does not explicitly disclose "a negotiation responding step which prepares an initial value, a pitch value, and a lowest value with respect to a bid price, first inputs response information in which the initial value has been set to said bid price, in the case where another response information of a cheap bid price is recognized in said negotiation field, again inputs response information in which the bid price has sequentially been corrected on a unit basis of said pitch value, and in the case where a bid price of a competitor is lower than said lowest value, stops the input of the response information and breaks off the negotiation.", Burchetta et al. ('551) discloses "a negotiation responding step which prepares an initial value, a pitch value, and a lowest value with respect to a bid price, first inputs response information in which the initial value has been set to said bid price, in the case where another response information of a cheap bid price is recognized in said negotiation field, again inputs response information in which the bid price has sequentially been corrected on a unit basis of said pitch value, and in the case where a bid price of a competitor is lower than said lowest value, stops the input of the response information and breaks off the negotiation".(Column 4, lines 48-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

Claims 15 and 16 are in parallel with claim 14 and are rejected for at least the same reasons.

*Allowable Subject Matter*

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Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

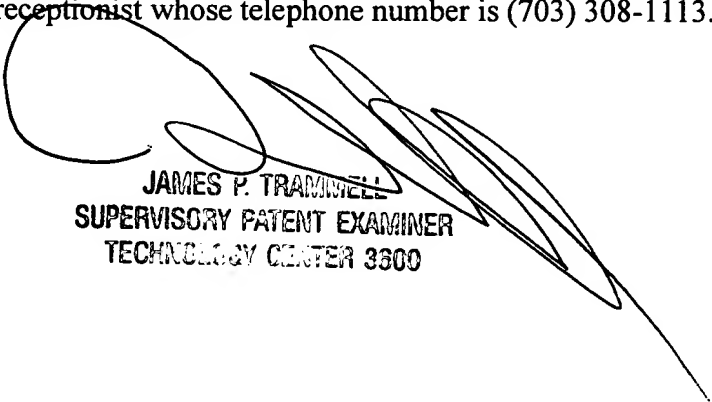
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

September 5, 2004  
JMW



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